

condition for allowance.

**1. Rejection of Claims 18-24 for Obviousness-Type Double Patenting**

The Official Action states that claims 18-24 have been rejected for the following reasons:

Claims 18-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,340,744. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions claim compositions comprising "a macrocycle" and other identical starting materials. In addition, the "non-aqueous" compositions claimed in the instant invention comprises the same active ingredient(s) as the compositions of U.S. Patent No. 6,340,744 even in the dry state because water was used as a solvent as a solvent for preparing the lanthanide compositions. Thus, there is substantial overlap of the subject matter claimed in both inventions.

It should be noted that applicants make the following arguments and comments based upon the claims as currently pending in this matter. As the prosecution of this application is not closed, such arguments and comments are made without prejudice to, or disclaimer of, any additional or different amendments, arguments, or comments as may be offered during the continuing prosecution of this application, as well as any divisional filing(s) or continuation(s) of this application.

Applicants respectfully traverse the obviousness-type double patenting rejection over U.S. Patent No. 6,340,744 on the ground that the instant claims are patentable under the proper one-way obviousness determination. The one-way test is proper since the

present application is not an earlier filed application (See MPEP § 804).

**Traversal: One-Way Obviousness Determination**

Under a one-way obviousness determination, an obviousness-type double patenting rejection is improper where the application claims are patentably distinct from the prior patent claims.

To establish a *prima facie* case of obviousness, or obviousness-type double patenting, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art reference must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

A *prima facie* case of obviousness, or obviousness-type double patenting, must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. See *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner bears the initial burden to provide

some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 974. Moreover, the rule of law requires that the Examiner must consider a reference in its entirety in determining the scope and content of the reference. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, (Fed. Cir 1983), *cert. denied*, 469 U.S. 851 (1984). Thus, the Examiner must acknowledge any disclosure in the reference that teaches away from the present invention. *Id.*

**A. The claimed subject matter**

Presently pending claim 18 relates to a spectrophotometrically detectable luminescent composition comprising water, a micelle-producing amount of at least one surfactant, at least  $1 \times 10^{-10}$  moles/liter of at least one energy transfer acceptor lanthanide element functionalized complex having certain specified physical features, and a luminescence-enhancing amount of at least one energy transfer donor compound of yttrium or a 3-valent lanthanide element having atomic number 59-71, provided that the lanthanide element of the functionalized complex and of the energy transfer donor compound are not identical.

Further, presently pending claim 20 specifies that the lanthanide element functionalized complex contains at least nine ring atoms of which at least three are donor atoms, claim 21 specifies that the lanthanide element functionalized complex has

eighteen ring members, claim 22 specifies that the composition is a cloudy solution, claim 23 specifies a composition resulting from the transfer of the composition of claim 18 to a nonaqueous environment, and claim 24 specifies a composition resulting from the transfer of the composition of claim 18 to a nonaqueous environment and removal of water.

**B. The claims of the '744 patent**

In contrast, claim 1 of the '744 patent claims a spectrophotometrically detectable luminescent composition comprising water, a micelle-producing amount of at least one surfactant, at least  $1 \times 10^{-10}$  moles/liter of at least one energy transfer acceptor lanthanide element macrocycle compound having certain specified physical features, and a luminescence-enhancing amount of at least one energy transfer donor compound of yttrium or a 3-valent lanthanide element having atomic number 59-71, provided that the lanthanide element of the macrocycle compound and of the energy transfer donor compound are not identical.

Further, claims 2-5 of the '744 patent specifies the particular surfactants used in the claimed composition, claim 6 of the '744 patent specifies that the lanthanide macrocycle compound has 4 nitrogen atoms and 2 additional specified atoms linked to the lanthanide atom, and claim 7 of the '744 patent specifies a particular genus for the lanthanide macrocycle compound.

**C. The differences between the claimed subject matter and  
the claims of the '744 patent**

Contrary to the Office Action, the '744 patent does not contain claims having the present inventive subject matter. In particular, claim 18 of the present application differs from claims 1-7 of the '744 patent by requiring a lanthanide element functionalized complex rather than a lanthanide element macrocycle compound. Contrary to the Examiner's assertion, presently pending claim 18 does not recite a composition comprising "a macrocycle". Rather, present claim 18 recites a "functionalized complex", a term that encompasses, and provides protection for, a wider variety of materials than does the term "macrocycle". Accordingly, presently pending claim 18 is not rendered obvious by claims 1-7 of the '744 patent as alleged by the Examiner.

Regarding presently pending claims 20 and 21, applicants note that none of claims 1-7 of the '744 patent specifically recite functionalized complexes containing "at least nine ring atoms of which at least three are donor atoms" or "eighteen ring members". Accordingly, presently pending claims 20 and 21 are further unobvious in view of claims 1-7 of the '744 patent.

Regarding presently pending claim 22, applicants note that none of claims 1-7 of the '744 patent in any way mention that the claimed compositions are a "cloudy solution". This critical feature of presently pending claim 22 is not recognized by claims

1-7 of the '744 patent identified by the Examiner, as required by *In re Wilson*. Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness against presently pending claim 22.

Similarly, applicants note that, contrary to the Examiner's assertions, none of claims 1-7 of the '744 patent in any way mention the "non-aqueous environment" limitation of presently pending claims 23 and 24. Accordingly, the Examiner has further failed to set forth a *prima facie* case of obviousness against presently pending claims 23 and 24 since claims 1-7 of the '744 patent do not recognize the "non-aqueous environment" feature, as required by *In re Wilson*.

#### **D. Terminal Disclaimer**

Despite the unobviousness of presently pending claims 18-24 over claims 1-7 of the '744 patent for the reasons set forth above, applicants submit herewith a terminal disclaimer against U.S. Patent No. 6,340,744 in accordance with MPEP § 804.02, removing the present grounds for rejection, merely to expedite prosecution of the present application. The filing of this terminal disclaimer is in no way an admission by applicants that presently pending claims 18-24 are, in fact, obvious in view of claims 1-7 of the '744 patent as asserted by the Examiner.

Accordingly, applicants respectfully request the Examiner to reconsider and withdraw the rejection of pending claims 18-24.

#### **CONCLUSION**

Based upon the above remarks, the presently claimed subject

matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the rejections of pending claims 18-24. Favorable action with an early allowance of all claims 1-24 pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if she has any questions or comments.

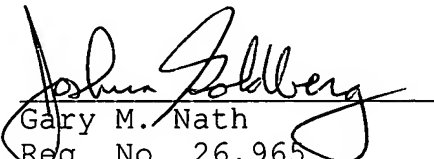
Respectfully submitted,

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